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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,003	08/13/2001	Yukio Yamaoka	YAMA3001/REF	5044
7590	11/19/2003		EXAMINER	
Bacon & Thomas 625 Slaters Lane 4th Floor Alexandria, VA 22314-1176			ELVE MARIA ALEXANDRA	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/926,003	YAMAOKA ET AL.
	Examiner M. Alexandra Elve	Art Unit 1726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-2 & 4-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-11 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shneerov et al. (US Pat. 4,843,212) and Cary.

Shneerov et al. discloses a welding wire, which is plated with copper. Welding wire is made from welding rods that are cold drawn to a diameter of 0.8mm. The ultimate tensile strength is 830 to 1320 MPa. Exact yield strengths are not taught. Cary discloses the mechanical properties, which range from 450 to 830 MPa for tensile strengths and 390 to 740 MPa for yield strengths. The resulting ratios range from 45 to 88%. It would have been obvious to one of ordinary skill in the art to use the mechanical properties of Cary in the Shneerov et al. wire because these are drawn to the same welding wire products.

Although the prior art teaches the same welding wire it does not teach the exact yield strengths, however, the range is the same, when statistical error is taken into consideration. If a composition is physically the same, it must have the same properties. A chemical composition and its properties are inseparable. Therefore the prior art

teaches the same chemical composition, the properties of instant claims are necessarily present. See *In re Spada*, 15 USPQ 2d 1655, 1658.

The exact elastic limit ratios are not taught, but the prior art ratios overlap and encompass instant claims ratios. If a composition is physically the same, it must have the same properties. A chemical composition and its properties are inseparable. Therefore the prior art teaches the same chemical composition, the properties of instant claims are necessarily present. See *In re Spada*, 15 USPQ 2d 1655, 1658.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shneerov et al. and Cary, as stated in the above paragraph.

Shneerov et al. and Cary does not specifically disclose the same processing steps.

The prior art discloses a product substantially similar to a claimed product, differing only in the manner by which it is produced. It has been held that one of ordinary skill in the art at the time of the invention would have considered the claimed compositions to have been obvious because of the similarity in the properties, and overlapping ranges. The burden falls to the applicant to show that any process steps associated with the claimed product result in a materially different product from those of the prior art, because there is nothing in the record before the examiner to reasonably conclude that applicant's product differs in kind from those obtained by the references.

See In re Brown 173 USPQ 685 and In re Fessmann 180 USPQ 324.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 13 has been renumbered to be 12 and misnumbered claim 14 has been renumbered to be 13.

Response to Amendment

Applicant's arguments with respect to claims 1-2 & 4-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is (703) 308-0092. The examiner can normally be reached Monday to Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn, can be reached on (703) 308-3318.

Any inquiry of general nature to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0661.



Michael J. Kline
PRIMARY EXAMINER

November 17, 2003.